

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)  
1736-000001/REB

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number  
10/643,674

Filed  
August 11, 2003

First Named Inventor  
HYON, Suong-Hyu

On \_\_\_\_\_

Art Unit  
1796

Examiner  
Susan W. Berman

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Applicant requests review of the final rejection in the above-identified application.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 30692.

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

David L. Suter  
Typed or printed name

(248) 641-1600  
Telephone number

April 28, 2009  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ \*Total of \_\_\_\_\_ forms are submitted.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/643,674  
Filing Date: August 19, 2003  
Applicant: Hyon et al.  
Group Art Unit: 1796  
Examiner: Susan W. Berman  
Title: ULTRA HIGH MOLECULAR WEIGHT POLYETHYLENE  
MOLDED ARTICLE FOR ARTIFICIAL JOINTS AND  
METHOD OF PREPARING THE SAME  
Attorney Docket: 1736-000001/REB

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Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**STATEMENT OF REASONS ACCOMPANYING A PRE-APPEAL BRIEF REQUEST  
FOR REVIEW AND NOTICE OF APPEAL**

Sir:

In response to the Final Rejection mailed October 28, 2008, Applicants have filed an Amendment after Final, a Notice of Appeal, and a Request for Pre-Appeal Brief Review. Before preparing the Appeal Brief, Applicants respectfully request review of any outstanding rejections that the Examiner may maintain after consideration of the Amendment after Final, in light of following discussion and the arguments of record.

## **REMARKS**

### **Procedural Status**

Applicants are filing an Amendment After Final (herein the "April 28, 2009 Amendment") on even date with the current Pre-Appeal Brief Request for Review. By amendment after final, Applicants have cancelled claims, leaving only two independent claims for review. The claims are not otherwise amended. They have also submitted a new declaration and addressed a provisional obviousness-type double patenting rejection to resolve some formal matters to simplify an eventual appeal. The April 28, 2009 Amendment also addresses the substantive recapture and obviousness rejections. To advance prosecution, Applicants have also filed a Notice of Appeal of even date in order to complete their responsive reply to the final rejection. To the extent that the Examiner does not withdraw a rejection on the basis of the evenly filed amendment, Applicants request review by the panel before preparing the Appeal Brief.

### **REJECTION UNDER 35 U.S.C. § 251**

Applicants respectfully request review of this rejection before preparing the Appeal Brief. Applicants respectfully maintain their position that the claims avoid the recapture rule for the reasons discussed in their November 20, 2007 Amendment.

The recapture rule embodied in 35 U.S.C. § 251 is said to prohibit a patentee from obtaining (or "recapturing") by reissue subject matter that was given up during prosecution of the original claims of the patent being reissued. The issue of recapture arises when any claim of a reissue application is broader in any way than the claims of the patent being reissued. But broadened claims avoid the recapture issue (and are allowable in a reissue) if broadening aspects are not related to subject matter given up during prosecution. And even if claims have broadening aspects related to surrendered subject matter, the recapture issue is avoided

notwithstanding those broadening aspects if the claims contain narrowing aspects that are not totally unrelated to rejections addressed during prosecution. As developed in the amendments of April 28, 2009 and November 20, 2007, the current reissue claims avoid the recapture rule for two main reasons.

First, broadening aspects in the claims are not related to subject matter surrendered during prosecution because the current claims are independent and distinct from the claims in the parent patent U.S. Patent 6,168,626. The current claims were offered along with the issued claims of the '626 patent in Reissue Application No. 10/141,374 filed August 23, 2002. The current claims were restricted by the Examiner because they were considered independent and distinct from the parent claims. As amended, a further distinction is shown in the fact that the current claims do not recite a step of cooling while keeping the deformed state, while all of the issued claims of the '626 patent contain that limitation. Restriction is proper and the claims are independent and distinct.

Accordingly, comments and amendments made in pursuing the claims that resulted in the allowed claims of the '626 patent are irrelevant to the recapture analysis of the claims in the current reissue application. Applicants respectfully request the recapture rejection be withdrawn.

Applicants also maintain their position that, even if broadening aspects of the claims are related to surrendered subject matter, the claims are nevertheless narrowed in other ways to avoid the recapture issue. As discussed in the November 20, 2007 Amendment, the current claims all recite that the temperature to which a crosslinked UHMWPE is heated is below the melting point. Had such a limitation been present or offered by amendment during prosecution of the original claims, those amended claims would have further distinguished over the cited art.

For all these reasons, Applicants respectfully request the recapture rejections be withdrawn.

**REJECTION UNDER 35 U.S.C. §§ 102/103**

***Rejection over Zachariades in view of Kitamaru***

Claims 40-53, 85-97, 100-101, 111-118, 128-134, and 136 are rejected as obvious over the *Zachariades* reference (U.S. Pat. No. 5,030,402) in view of the *Kitamaru* reference (U.S. Pat. No. 3,886,056). Applicants respectfully traverse the rejection as applied to the amended claims and request reconsideration.

As discussed in the November 20, 2007 Amendment, it is not clear why a person of skill in the art would combine the references by adding some aspects of *Zachariades* to *Kitamaru* (such as the heat treatment below the melting point), but not others (direct molding to a final implant, use of a non-crosslinked UHMWPE.) Applicants note that in the Final Rejection, the references are applied in the opposite way, with *Zachariades* primary and *Kitamaru* as secondary. Applicants believe this does not change the analysis. Regardless of how the references are combined, the person of skill in the art has to pick and choose which of the features of one to add to the other. This amounts to impermissible hindsight based on Applicants' disclosure of their own invention.

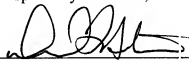
For these reasons, Applicants respectfully request the art rejections be withdrawn.

CONCLUSION

Before preparing the appeal brief, Applicants respectfully request review and removal of the outstanding recapture and art rejections. The Examiner and the Appeal Review Panel are invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

Dated: April 28, 2009

By:   
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